



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,061	02/17/2004	Calvin Lam	C&M1.PAU.18	2786
23386	7590	02/10/2006	EXAMINER	
MYERS DAWES ANDRAS & SHERMAN, LLP 19900 MACARTHUR BLVD., SUITE 1150 IRVINE, CA 92612			CANFIELD, ROBERT	
			ART UNIT	PAPER NUMBER
			3635	

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/780,061

Applicant(s)

LAM, CALVIN

Examiner

Robert J. Canfield

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 12-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 25-29 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/15/05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3635

1. This is a first Office action on the merits for application serial number 10/780,061 filed 02/17/04. Claims 1-29 are pending.

2. Applicant's election with traverse of Group I, claims 1-12 and 25-29 in the reply filed on 01/23/06 is acknowledged. No grounds for traverse are presented.

The requirement is still deemed proper and is therefore made FINAL.

3. Claim 1 is objected to because of the following informalities: at line 3 "on" should be -- one --. Appropriate correction is required.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-7 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,383,508 to Pavlica et al.

Pavlica provides a cornice having a base 46 with decorative module 24, 36, and 42 fastened thereto. The top and bottom portions are replaceable with different fascias/surfaces (col. 3, lines 3-5) and placards 42 are interchangeable. The top and bottom members 24, 26 are inherently fastened to the base 46 and the placard is fastened by the channels 30, 38. The top and bottom members are shown with curved surfaces.

Art Unit: 3635

6. Claims 1, 4, 5, 7-9 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,470,639 to Horn et al.

Horn provides a base 282 having decorative modules 300 and 302 attached thereto by T-shaped fasteners (figure 9) or alternatively L-shaped fasteners (figure 6). A centerpiece 290 is held within an insert channel formed by the base and modules. The recitation cornice has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hira*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,383,508 to Pavlica et al.

Each of the elements of the claims are provided except that the elements are made of wood. Wood is a known material for valence or cornice structures as

Art Unit: 3635

noted in the background of the invention in Pavlica. Wood would have been an obvious material choice for the elements of Pavlica to one having ordinary skill in the art at the time of the invention for its inherent material properties and because it is suggested within Pavlica as a known material for the claimed environment.

9. Claims 10, 11, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,470,639 to Horn et al.

Horn provides each of the elements of these claims as noted above except that the T or L-shaped channels are provided in the base member.

It would have been obvious at the time of the invention to one having ordinary skill in the art that the orientation of the T and L-shaped fastening arrangement of Horn could have been reversed without any unexpected results. It would have been obvious that the fastening arrangement would function the same regardless of which of the elements is grooved to receive the head of the fastening member and which is grooved to receive the base.

10. The examiner acknowledges receipt of the IDS filed 03/15/05. An initialed copy of the 1449 form is attached.

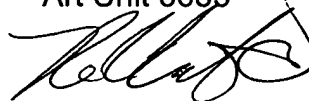
11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Canfield whose telephone number is 571-272-6840. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert J Canfield
Primary Examiner
Art Unit 3635



02/03/06

Replacement Sheet



OK
to enter (2)
2/3/06

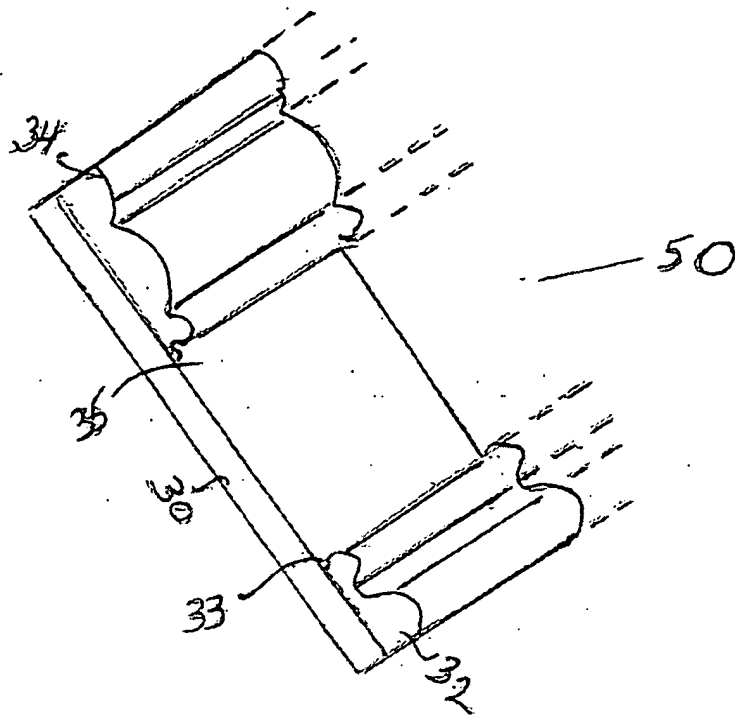


Fig. 7

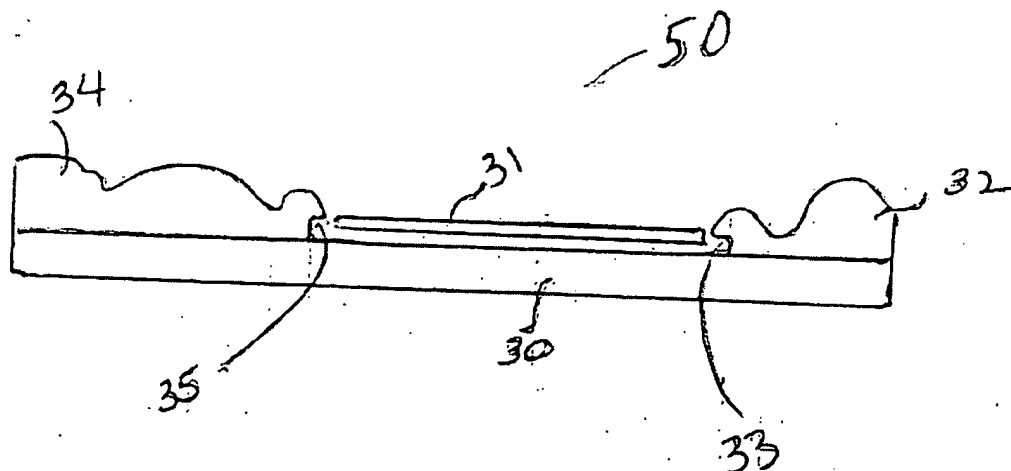


Fig. 8